

REMARKS**Summary of the Office Action**

Claims 1-8, 11-16, 18, 19, 21 and 22 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,230,591 to Katbi et al. ("Katbi").

Claims 17 and 20 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0202515 to Satran et al. ("Satran").

Claims 9 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Katbi, in view of U.S. Patent No. 6,234,726 to Okada et al. ("Okada").

The Information Disclosure Statement Filed on October 20, 2004

Applicants respectfully request that the Examiner evidence consideration of all five references cited in the IDS filed on October 20, 2004, by initialing all five references listed on the corresponding Form 1449 and returning a copy of same to Applicants.

All Claims Define Allowable Subject Matter

Claims 1-8, 11-16, 18, 19, 21 and 22 are rejected under 35 U.S.C. § 102(b) as being anticipated by Katbi. Applicants respectfully traverse the rejection under 35 U.S.C. § 102(b). Claim 1 recites a cutting insert, including top and bottom surfaces interconnected by a peripheral surface. At least one of the top and bottom surfaces constitutes a cutting surface. A cutting edge is disposed between the cutting surface and the peripheral surface. The cutting surface includes a plateau surface and a rake surface. The rake surface surrounds the plateau surface and is situated between the plateau surface and the cutting edge. A step is disposed between the plateau surface

and the rake surface. The step includes lateral step portions and corner step portions, and varies in height such that a maximum height is disposed at the corner step portions.

In contrast, Katbi discloses a cutting insert having a step of uniform height all along the circumference of the cutting insert. As illustrated in Fig. 1 and Fig. 4 of Katbi, a cutting insert 10 includes a cutting surface 36 having a cutting edge 38, a step 48, and a rake 46 disposed between the cutting edge 38 and the step 48. As described at col. 2, ll. 45-47, the cutting edge 38 is in the shape of a descending arc 40 from corner to each adjacent corner of the insert. However, irrespective of the arc shape of the cutting edge, as clearly illustrated in Fig. 1, the height of the step 48 is uniform all along the circumference of the cutting insert. There is no variation at all. The height of the step is the same at the corner of the cutting insert as well as at the middle between two corners. Thus, Applicants respectfully submit that Katbi does not teach at least the features of a step that includes lateral step portions and corner step portions, and that varies in height such that a maximum height is disposed at the corner step portions, as recited in claim 1.

Claims 2-8, 11-16, 18, 19, 21 and 22 depend from claim 1, and recite the same combination of allowable features recited in claim 1, as well as additional features that define over the prior art. Accordingly, it is requested that the rejection under 35 U.S.C. § 102(b), of claims 2-8, 11-16, 18, 19, 21 and 22, be withdrawn.

Claims 9 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Katbi, in view of Okada. Applicants respectfully traverse the rejection under 35 U.S.C. § 103(a). Claims 9 and 10 depend from claim 1, and recite the same combination of allowable features recited in claim 1, as well as additional features that define over the prior art. Applicants

respectfully submit that Okada fails to overcome the above-described deficiencies of Katbi.

Accordingly, it is requested that the rejection under 35 U.S.C. § 103(a), of claims 9 and 10, be withdrawn.

Claims 17 and 20 are rejected under 35 U.S.C. § 102(e) as being anticipated by Satran. Applicants respectfully submit that Satran should not be considered as prior art in the present application under any subsection of 35 U.S.C. § 102. On April 19, 2004, Applicants filed a Claim for Priority and a Certified copy of German Patent Application No. 103 17 760.4 which was filed in Germany on April 17, 2003. Pursuant to 37 C.F.R. § 1.55(a), Applicants submit concurrently herewith a verified translation of German Patent Application No. 103 17 760.4. The U.S. filing date of Satran is April 1, 2004, which is after the priority date to which the instant application is entitled. Accordingly, Applicants submit that Satran should not be considered as prior art in the present application under any subsection of 35 U.S.C. § 102. It is requested that the rejection under 35 U.S.C. § 102(e), of claims 17 and 20, be withdrawn. Applicants submit that all pending claims are in condition for allowance.

CONCLUSION

In view of the foregoing, Applicants submit that the pending claims are in condition for allowance, and respectfully requests reconsideration and timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution. A favorable action is awaited.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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